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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/743,758	01/16/2001	Ralf Schweinfurth	MERCK 2192	7747

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MILLEN, WHITE, ZELANO & BRANIGAN, P.C.  
2200 CLARENDON BLVD.  
SUITE 1400  
ARLINGTON, VA 22201

EXAMINER

BHAT, NINA NMN

ART UNIT	PAPER NUMBER
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1761

DATE MAILED: 04/21/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/743,758

Applicant(s)

SCHWEINFURTH ET AL.

Examiner

N. Bhat

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-- Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 16 April 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. Applicant is requested to amend the specification to add on Page 1, line 1, "This application claims benefit under 35 U.S.C. 371 of PCT/EP99/04792 filed July 8, 1998."
2. Claims 1-11 provides for the use of titanium dioxide pigments and/or iron oxide pigments based on platy substrates for coloring food products or pharmaceutical products, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claims 1-11 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

3. Claims 1-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In all of the claims applicant has used "characterized in that" language. Applicant is requested to draft claims in clear, positive, meaningful language avoiding recitations like characterized in that because it is unclear what characteristics are being claimed. Applicant can obviate the rejection by deleting "characterized in that" and replacing it with --wherein—. In claim 1 applicant uses and/or iron oxide, in dependent claims applicant refers to the iron oxide pigment, it is

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unclear with the and/or language if the applicant is providing a platy substrate which includes both titanium dioxide and iron oxide and the dependent claims. Claims 4 and 5 are confusing with the and/or language being using in both independent claims and in claim 4 and 5. Applicant is suggested to draft claims which recite titanium dioxide alone, titanium dioxide and iron oxide, and iron oxide alone and eliminate the and/or language from the claims. Claim 10 is an incomplete process claim because applicant has not provided any steps of the process and merely recites the composition of the pigment used in a food or pharmaceutical.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Brand et al.

Brand et al. teach a colored nacreous pigments provided based on a platy substrate (mica coated flakes) which have been coated with two superimposed layers, the first layer being titanium and/or zirconium oxide mixed with an another metallic oxide which includes iron oxide which produces a high luster pigment which can be used as road markers, road signs, children's toys, wall coverings, lipstick, and soaps. The pigment is used in a lipstick mass in amount of 15% by weight. The titanium dioxide pigments and/or iron oxide pigments based on platy substrates for coloring food

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products or pharmaceutical products has been fully taught in Brand et al. [Note Column 1, line 14-20, Column 3, lines 24 et seq., Note Column 11, lines 28-30 and Column 12, line 1-38]

6. Claims 1,2,6, 10 and 11 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Noguchi et al.

Noguchi et al. teach a flaky pigment comprising a flaky substrate and particles of a pigment or dye. The flaky pigment particles include metal oxide coated mica, kaolin. The flaky pigment is used in cosmetic compositions. Specifically taught is providing titanium oxide -coated mica blended with organic pigment. [Note the abstract, Column 2, lines 30-37, Example 3, 6 and 7 found in Column 6, and Column 9, lines 1-40] thus anticipating applicant's claims.

7. Claims 1-3, 5-8 and 10-11 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Bernhard who teaches gold colored nacreous pigments product from mica flakes coated with a layer of titanium dioxide and/or zirconium dioxide and includes a layer of iron oxide.[Note the Claims]

8. Claims 1-3, 5-8 and 10-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Linton.

Linton teaches a nacreous pigment composition which teaches a non opaque flake substrate and a thin translucent layer of metal oxide which includes metal oxide layer of titanium dioxide or zirconium oxide and may includes a second oxide either as a separate layer or in admixture with the titanium or zirconium dioxide.[Note Column 4] The second oxide can include a metal oxide such as iron oxide or nickel oxide, cobalt

oxide or chromium oxide.[Note Column 10, lines 16-26] Linton teaches that the nacreous pigments can be used in cosmetic formulations such as nail lacquers.

9. Claims 1-2 and 6 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Ahmed et al or Bernhard et al.

Ahmed et al. teach a lustrous color nacreous pigment prepared by admixing a laking reagent with an aqueous dispersion of a metal oxide coated substrate nacreous pigment and dyestuff. The nacreous pigment is a titanium dioxide coated mica pigment.[Note Column 1, lines 22-53, Column 4, line 23-38] Ahmed et al. teach a lustrous color nacreous pigment fully anticipates applicant's claims.

Bernhard et al. teach dyed lustrous pigments, which includes titanium dioxide pigments, and/or iron oxide pigments based on platy substrates for coloring pharmaceutical or cosmetics. Note Example 2, Example 6, Example 7 and Example 8]

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Gale et al. teach blended nacreous pigments used in cosmetic applications. WO 99/43755 teach pearlescent pigment which is ferrite coated iron oxide coated play substrate in which the ferrite is free of crystallites. Jones teach pearlescent pigments containing ferrites. Gale'260 teach pearlescent pigments which includes titanium dioxide coated mica and a quantity of iron oxide coating. DeLuca, Jr. et al. teach bonded metal hydroxide organic composite polymer films on lamellar pigments.

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11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to N. Bhat whose telephone number is 703-308-3879. The examiner can normally be reached on Monday-Friday, 9:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on 703-308-3959. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-5665.



N. Bhat  
Primary Examiner  
Art Unit 1761

April 16, 2003